

PATENT**Serial No. 10/063,120****Docket No. 112631 CIP (1014-126)****REMARKS**

The Examiner is respectfully thanked for the consideration provided to this application. Reconsideration of this application is respectfully requested in light of the foregoing amendments and the following remarks.

Each of claims 1 and 8 was amended has been amended for reasons unrelated to patentability, including at least one of: to address an informality, explicitly present one or more elements implicit in the claim as originally written when viewed in light of the specification, thereby not narrowing the scope of the claim; to detect infringement more easily; to enlarge the scope of infringement; to cover different kinds of infringement (direct, indirect, contributory, induced, and/or importation, etc.); to expedite the issuance of a claim of particular current licensing interest; to target the claim to a party currently interested in licensing certain embodiments; to enlarge the royalty base of the claim; to cover a particular product or person in the marketplace; and/or to target the claim to a particular industry.

Claims 1-14 are now pending in this application. Each of claims 1 and 8 are in independent form.

The Claim Objections

Each of claims 1-8 were objected to because "they are written in an outline format (a), (b), etc.), and should be written in sentence form." See page 2 of Office Action. Each of claims 1 and 8 have been amended to address this informality. Thus, Applicant respectfully requests withdrawal of each objection to claims 1-8 and requests written confirmation thereof.

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The Anticipation Rejections

Each of claims 1-3 and 8-10 was rejected as anticipated under 35 U.S.C. 102(e). In support of the rejection, Donohue (U.S. Patent No. 5,987,480) was cited. These rejections are respectfully traversed.

Donohue fails to establish a prima facie case of anticipation. *See* MPEP 2131. To anticipate expressly, the “invention must have been known to the art in the detail of the claim; that is, all of the elements and limitations of the claim must be shown in a single prior art reference, arranged as in the claim”. *Karsten Mfg. Corp. v. Cleveland Golf Co.*, 242 F.3d 1376, 1383, 58 USPQ2d 1286, 1291 (Fed. Cir. 2001). The single reference must describe the claimed subject matter “with sufficient clarity and detail to establish that the subject matter existed in the prior art and that its existence was recognized by persons of ordinary skill in the field of the invention”. *Crown Operations Int’l, LTD v. Solutia Inc.*, 289 F.3d 1367, 1375, 62 USPQ2d 1917, 1921 (Fed. Cir. 2002). Moreover, the prior art reference must be sufficient to enable one with ordinary skill in the art to practice the claimed invention. *In re Borst*, 345 F.2d 851, 855, 145 USPQ 554, 557 (C.C.P.A. 1965), *cert. denied*, 382 U.S. 973 (1966); *Amgen, Inc. v. Hoechst Marion Roussel, Inc.*, 314 F.3d 1313, 1354, 65 USPQ2d 1385, 1416 (Fed. Cir. 2003) (“A claimed invention cannot be anticipated by a prior art reference if the allegedly anticipatory disclosures cited as prior art are not enabled.”) The USPTO “has the initial duty of supplying the factual basis for its rejection.” *In re Warner*, 379 F.2d 1011, 154 USPQ 173, 178 (C.C.P.A. 1967).

Each of independent claims 1 and 8, from one of which each of claims 2-7 and 9-14 depend, recite “responsive to a request from a browser, **providing to said browser a wrapper document comprising a scripting program**, said scripting program executable by said browser to: retrieve a template comprising one or more inclusion markups; parse the template for the inclusion markups; retrieve from a server connected to the data network an included data object identified in an inclusion markup; and display the included data objects to the user.” Donohue does not expressly or inherently teach or suggest “responsive to a request from a browser,

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providing to said browser a wrapper document comprising a scripting program, said scripting program executable by said browser to: retrieve a template comprising one or more inclusion markups; parse the template for the inclusion markups; retrieve from a server connected to the data network an included data object identified in an inclusion markup; and display the included data objects to the user."

Instead, Donohue allegedly recites the **"server computer selects one of the document templates corresponding to the desired document, populates the document template with content stored in the data source based on respective values of content corresponding to names in the dynamic tags and flow directives, and delivers the populated document to the client computer."** See Abstract.

Accordingly, it is respectfully submitted that the rejection of claims 1 and 8 is unsupported by Donohue and should be withdrawn. Also, the rejection of claims 2-7 and 9-14, each ultimately depending from one of independent claims 1 or 8, is unsupported by Donohue and also should be withdrawn.

The Obviousness Rejections

Each of claims 4-6 and 11-13 was rejected under 35 U.S.C. 103(a) as being unpatentable over Donohue (U.S. Patent No. 5,987,480) and further in view of Wood ("Document Object Model (DOM) Level 1 Specification"). These rejections are respectfully traversed.

Each of claims 7 and 14 was rejected under 35 U.S.C. 103(a) as being unpatentable over Donohue (U.S. Patent No. 5,987,480) and further in view of Tsimelzon ("ESI Language Specification 1.0"). These rejections are respectfully traversed.

None of the cited portions of the applied references, alone or in combination, establish a *prima facie* case of obviousness. "To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify

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the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure." *See* MPEP 2143. Moreover, the USPTO "has the initial duty of supplying the factual basis for its rejection." *In re Warner*, 379 F.2d 1011, 154 USPQ 173, 178 (C.C.P.A. 1967).

As stated above, each of independent claims 1 and 8 recite, yet Donohue fails to expressly or inherently teach or suggest "responsive to a request from a browser, providing to said browser a wrapper document comprising a scripting program, said scripting program executable by said browser to: retrieve a template comprising one or more inclusion markups; parse the template for the inclusion markups; retrieve from a server connected to the data network an included data object identified in an inclusion markup; and display the included data objects to the user." Neither Wood nor Tsimelzon overcome the deficiencies of Donohue.

Thus, even if there were motivation or suggestion to modify or combine the applied portions of the cited references (an assumption that is respectfully traversed), and even if there were a reasonable expectation of success in combining or modify the applied portions of the cited references (another assumption that is respectfully traversed), the applied portions of the cited references still do not expressly or inherently teach or suggest **every** limitation of the independent claims, and consequently fail to establish a *prima facie* case of obviousness.

Because no *prima facie* rejection of any independent claim has been presented, no *prima facie* rejection of any dependent claim can be properly asserted. Consequently, reconsideration and withdrawal of the rejections of each of claims 1-8 is respectfully requested.

Allowable Subject Matter

The following is a statement of reasons for the indication of allowable subject matter:

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“none of the references of record alone or in combination disclose or suggest the combination of limitations found in the independent claims. Namely, claims 1-14 are allowable because none of the references of record alone or in combination disclose or suggest ‘responsive to a request from a browser, providing to said browser a wrapper document comprising a scripting program, said scripting program executable by said browser to: retrieve a template comprising one or more inclusion markups; parse the template for the inclusion markups; retrieve from a server connected to the data network an included data object identified in an inclusion markup; and display the included data objects to the user.’”

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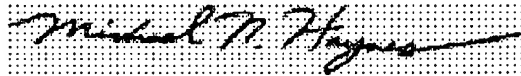
CONCLUSION

It is respectfully submitted that, in view of the foregoing amendments and remarks, the application as amended is in clear condition for allowance. Reconsideration, withdrawal of all grounds of rejection, and issuance of a Notice of Allowance are earnestly solicited.

The Office is hereby authorized to charge any additional fees or credit any overpayments under 37 C.F.R. 1.16 or 1.17 to Deposit Account No. 50-2504. The Examiner is invited to contact the undersigned at 434-972-9988 to discuss any matter regarding this application.

Respectfully submitted,

Michael Haynes PLC

A handwritten signature in black ink, reading "Michael N. Haynes", is written over a rectangular area with a dotted background pattern.

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Michael N. Haynes
Registration No. 40,014

1341 Huntersfield Close
Keswick, VA 22947
Telephone: 434-972-9988
Facsimile: 815-550-8850